

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

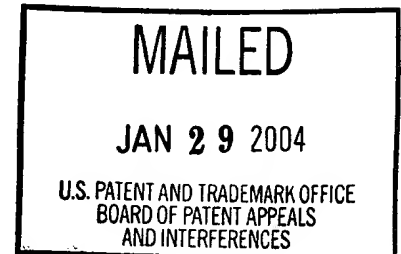
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN W. MERILL

Appeal No. 2001-2630
Application No. 09/115,359

ON BRIEF



Before JERRY SMITH, BLANKENSHIP, and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant requests that we reconsider our decision of October 27, 2003 wherein we affirmed the examiner's rejection of claims 14, 15, 25-27 and 29-32 as unpatentable under 35 U.S.C. § 102(e) and the rejection of claims 21-24 and 28 as unpatentable under 35 U.S.C. § 103(a).

We have reconsidered our decision of October 27, 2003 in light of appellant's comments in the request for rehearing, and we find no error therein. We, therefore, decline to make any changes in our prior decision for the reasons which follow.

Appellant's request for rehearing is only directed to the decision by the Board with respect to claim 14. The only argument made by appellant in the request for rehearing raises a question of fact which was not argued before the examiner and was not argued in the appeal brief. In the original appeal brief, appellant elected to have the appeal decided on a very narrow question. Specifically, appellant's only argument was that the commands object in the reference has a voice property which specifies that the object may respond to either spoken or non-spoken commands, but not both [brief, pages 8-9]. The Board considered this single argument and found it unpersuasive.

The present request for rehearing raises the question of whether there is an object in Trower that receives spoken and non-spoken command information. As noted above, the argument in the brief appeared to concede that Trower taught a commands object, and the only question was whether this commands object in Trower received both spoken and non-spoken command information. This argument was considered and was decided adversely to appellant. The question of whether the element which receives spoken and non-spoken command information in Trower meets the technical definition of an object raises a factual question which could have been, and should have been, argued before the examiner. Since appellant never raised this factual question with the examiner in the appeal brief, we do not have the

benefit of the examiner's position on this question of fact. A new argument advanced in a request for rehearing but not advanced in the brief or reply brief is not properly before the Board because an argument advanced in such a manner has not afforded the examiner an opportunity to respond to the new argument. Note Ex parte Hindersinn, 177 USPQ 78 (Bd. App. 1971). Consequently, we will not consider this new argument of fact as a basis for changing our prior decision in this case. Since the only argument in the request for rehearing is not timely made in this appeal, we find no reason to modify our prior decision.

In summary, we have considered the argument raised by appellant in his request for rehearing, but we can find no errors in our original decision. We are still of the view that the examiner's rejection of claims 14, 15 and 21-32 was correct based on the record that was presented to us.

We have granted appellant's request to the extent that we have reconsidered our decision of October 27, 2003, but we deny the request with respect to making any changes therein.

REHEARING DENIED

<i>Jerry Smith</i>)	
Jerry Smith)	
Administrative Patent Judge)	
<i>Howard B. Blankenship</i>)	
Howard B. Blankenship)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
<i>Mahshid D. Saadat</i>)	INTERFERENCES
Mahshid D. Saadat)	
Administrative Patent Judge)	

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